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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/591,158	06/09/2000	Monica A. Marics	MEDO 5029 PUS	2781

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BROOKS & KUSHMAN
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EXAMINER

LIN, WEN TAI

ART UNIT	PAPER NUMBER
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2154

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DATE MAILED: 07/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/591,158

Applicant(s)

MARICS ET AL.

Examiner

Wen-Tai Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2,4</u> . | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Claims 1-35 are presented for examination.
2. Claims 11-13 are objected to because it is not clearly understand what is meant by “the at least one electronic signal includes a plurality of electronic signals” in claim 11 [i.e., “the at least one electronic signal” can include a plurality of other type of electronic signals”? Or else how can a potentially singular signal includes a plurality of same type of signal?]. Clarification/Correction is required in response to this office action.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-3 and 5-35 are rejected under 35 U.S.C. 102(e) as being anticipated by MACRAE et al. (hereafter “MACRAE”) [U.S. PGPub 20030005463].

5. MACRAE is a PGPub of PCT/US97/18664, of which publication (WO98/17064) was cited in the IDS filed on 4/10/2002.

6. As to claims 1 and 20, MACRAE teaches the invention as claimed including: a system for providing Internet addresses corresponding to an electronic signal to a user, the system comprising:

- a receiver for receiving at least one electronic signal, the at least one electronic signal including one or more Internet addresses embedded therein [Abstract];
- a decoder in communication with the receiver, the decoder for extracting the one or more Internet addresses from the at least one electronic signal [35, Fig.1; paragraph 24];
- a processor in communication with the decoder [24, Fig.1], the processor for compiling a historical list of the one or more Internet addresses extracted from the at least one electronic signal, wherein the processor includes memory [36, Fig.1] for storing the historical list [paragraph 50]; and
- a web browser connected to the processor, the web browser for presenting the historical list of the one or more Internet addresses to the user [paragraph 50].

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7. As to claim 2, MACRAE teaches that the processor is further operable to receive a signal from the user indicating a selected Internet address from the historical list and provide a connection to a web page associated with the selected Internet address [paragraph 51].

8. As to claims 3 and 5-6, MACRAE further teaches that the processor includes a personal computer or a web tablet, and the receiver includes a set-top box [70, 74, 98, Fig.7; paragraphs 38-53].

9. As to claims 7-8, MACRAE teaches that the system further comprising a first display [74, Fig.7; i.e., by default the internet access terminal has a display unit] in communication with the processor [76, Fig.7], wherein the processor is in communication with the receiver [72, 89, Fig.7], and the at least one electronic signal is displayed on the first display.

10. As to claims 9-10, MACRAE teaches that the system further comprising a second display in communication with the receiver for displaying the at least one electronic signal to the user, wherein the second display includes a television set [70, Fig.7].

11. As to claim 11, MACRAE further teaches that the at least one electronic signal includes a plurality of other electronic signals [i.e., by default the received electronic

signal contains the mixture of a plurality of electronic signals broadcast from different TV stations].

12. As to claim 12, MACRAE teaches that the system further comprises a tuner in communication with the receiver for tuning to a selected one of the plurality of electronic signals [note that this is an inherent function of a tuner (i.e., the TV receiver)].

13. As to claim 13, MACRAE further teaches that the historical list includes Internet addresses extracted from the plurality of electronic signals [paragraph 50].

14. As to claim 14, MACRAE further teaches that the historical list includes Internet addresses extracted over an amount of time selectable by the user [paragraph 50; i.e., on a first-in-first-out basis].

15. As to claim 15, MACRAE further teaches that the historical list includes Internet addresses of a number selectable by the user [paragraph 50; i.e., i.e., when a new website address and title is received, it is stored in memory in place of either the most infrequently accessed website address/title].

16. As to claim 16, MACRAE further teaches that the historical list includes program source information associated with each Internet address [i.e., the title is a program source information].

17. As to claims 17-19, MACRAE further teaches that the at least one electronic signal includes a video signal, an audio signal or both [paragraph 21].

18. As to claim 21, MACRAE further teaches that the Internet addresses are embedded in a vertical blanking interval of the at least one electronic signal [paragraph 24].

19. As to claims 22-35, since the features of these claims can also be found in claims 1-3, and 5-21, they are rejected for the same reasons set forth in the rejection of claims 1-3 and 5-21 above.

Claim Rejections - 35 USC § 103

20. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

21. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over MACRAE et al.(hereafter "MACRAE")[U.S. PGPub 20030005463], as applied to claims 1-3 and 5-35 above.

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22. As to claim 4, MACRAE does not specifically teach that the receiver includes a home gateway.

However it is well known that a home gateway is simply a gateway to connect to a home network wherein PC or home entertainment equipments can be interconnected.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the home gateway as a possible source of receiver signal, because by doing so MACRAE's system can be further expanded to include other sources of video or audio signals, where relevant URLs could be retrieved from the signals and causing relevant internet information to be displayed [see also paragraphs 53-54 for motivation].

23. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Rosin et al. [U.S. Pat. No. 6028600];

Wolzien [U.S. Pat. No. 5761606];

Ullman et al. [U.S. Pat. No. 6018768]; and

Wharton et al. [U.S. Pat. No. 5831664].

24. A shortened statutory period for response to this action is set to expire 3 (three) months and 0 days from the mail date of this letter. Failure to respond within the period

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for response will result in ABANDONMENT of the application (see 35 U.S.C. 133, M.P.E.P. 710.02, 710.02(b)).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wen-Tai Lin whose telephone number is (703)305-4875. The examiner can normally be reached on Monday-Friday(8:00-5:00) .

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Meng-Ai An can be reached on (703)305-9678. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

(703)746-7239 for official communications;

(703)746-7238 for after final communications; and

(703)746-5516 for status inquires draft communication.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

Wen-Tai Lin

July 24, 2003

Wen-Tai Lin
7/24/03